

### REMARKS

Claims 1-29 were originally filed in this application. With the entry of the Response to Restriction Requirement filed on March 12, 2004 (the "March 12, 2004 Response"), claims 1-3, 7-9, 13-16, 24-26, 28 and 29 were pending in the above-identified patent application.

Applicants hereby cancel claims 13-16, 28 and 29 without prejudice to Applicants' right to pursue the subject matter of the cancelled claims in related applications. Applicants also hereby amend claim 24 and add new claims 30-32 to more clearly point out and distinctly claim the subject matter of certain embodiments of the present invention. Specifically, claim 24 has been amended to recite polypeptides that comprise: a) the amino acid sequence of SEQ ID NO: 2; b) an amino acid sequence that is a derivative of the amino acid sequence of SEQ ID NO: 2; and c) a fragment of the amino acid sequence of SEQ ID NO: 2; and new claims 30-32 have been added to recite polypeptides that comprise: a) the amino acid sequence of SEQ ID NO: 4; b) an amino acid sequence that is a derivative of the amino acid sequence of SEQ ID NO: 4; and c) a fragment of the amino acid sequence of SEQ ID NO: 4. Support for the new claims can be found in the specification at, *inter alia*, page 6, line 22 to page 11, line 9; and previously pending claim 24(d)-(f). No new matter has been added.

Upon entry of this amendments, claims 1-3, 7-9, 24-26, and 30-32 will be pending in the present application.

In this Office Action, the Examiner contends that the March 12, 2004 Response is not fully responsive to the prior Office Action because Applicants failed to elect either SEQ ID NO:2 or SEQ ID NO:4. For the following reasons, Applicants contend that this further restriction requirement is improper.

Nonetheless, in order to be fully responsive, Applicants hereby provisionally elect SEQ ID NO:2, with traverse.

The Manual of Patent Examining Procedure (MPEP) (8th edition, 2001) states that restriction is proper only when (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner to search and examine the claims to the independent or distinct inventions. See MPEP § 803.

Applicants submit that the amino acid sequences of SEQ ID NOS: 2 and 4 are related inventions; they are neither independent nor distinct. In particular, SEQ ID NO:2 is the amino acid sequence of ADPI-41, which is the protein isoform related to sideroflexin 1 (see, e.g., page 1, lines 1-3; and page 4, lines 28-29 of the specification), and SEQ ID NO:4 is the amino acid sequence of the splice variant identified for ADPI-41 (see, e.g., page 5, lines 1-3

of the specification). Further, the amino acid sequences of SEQ ID NOS: 2 and 4 show high sequence identity, *i.e.*, amino acid residues 1-198 of SEQ ID NO: 2 (322 amino acid residues in length) and amino acid residues 1-198 of SEQ ID NO: 4 (252 amino acid residues in length) are identical except for amino acid residue 154. As such, SEQ ID NOS: 2 and 4 are related amino acid sequences that have been improperly restricted. See MPEP § 803.

Even assuming *arguendo* that the amino acid sequences of SEQ ID NOS: 2 and 4 are independent and distinct inventions, Applicants submit that examination of both the amino acid sequences of SEQ ID NOS: 2 and 4 is not unduly burdensome. The Examiner's attention is respectfully directed to the Section 803 of the MPEP:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (emphasis added)

Applicants further direct the Examiner's attention to Section 803.04 of the MPEP, which discusses situations under which the Patent Office has decided *sua sponte* to partially waive the requirements of 37 C.F.R. § 1.141 and permit a reasonable number of nucleotide sequences or amino acid sequences, *e.g.*, ten, to be claimed in a single application. Applicants submit that the examination of SEQ ID NOS: 2 and 4 only require a search of two amino acid sequences, and that the search and examination of two amino acid sequences does not constitute serious burden on the Examiner.

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn.

Applicants reserve the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully request that the above remarks be entered and made of record in the file history of the instant application.

Respectfully submitted,

Date: July 6, 2004

  
Laura A. Coruzzi

30,742  
(Reg. No.)

**JONES DAY**

222 East 41<sup>st</sup> Street

New York, New York 10017

(212) 326-3939

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Herath et al. Confirmation No.: 1523  
 Application No.: 10/014,338 Art Unit: 1647  
 Filed: December 10, 2001 Examiner: Turner, Sharon L.  
 For: ADP-41, A NOVEL PROTEIN FROM BRAIN TISSUE  
 HOMOGENATE AND USES THEREFOR Attorney Docket No.: 9195-077-999

FEE TRANSMITTAL SHEET

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

The fee required to be filed with the accompanying amendment of even date herewith concerning the above-identified application has been estimated to be \$0.00.

The claim amendment fee has been estimated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)	<input type="checkbox"/> SMALL ENTITY		<input checked="" type="checkbox"/> OTHER THAN A SMALL ENTITY		
CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREVIOUSLY PAID	PRESENT EXTRA	RATE	ADDIT FEE	OR	RATE	ADDIT. FEE
TOTAL 12 MINUS 37	0	x 9	\$			x 18	\$ 0.00
INDEP. 4 MINUS 9	0	x 43	\$			x 86	\$ 0.00
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM			\$			\$	0.00
TOTAL			\$		OR	TOTAL	\$ 0.00

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I hereby certify that this paper is being filed with the United States Patent and Trademark Office by facsimile transmission on July 6, 2004 to facsimile telephone number (703) 872-9306.

  
 Ann Whei Chen

49,013

(Reg. No.)

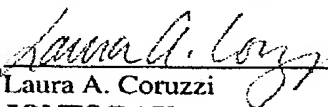
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NYJD: 1532287.1

Please charge the required fee to Jones Day Deposit Account No. 50-3013. A copy of this sheet is enclosed.

Respectfully submitted,

Date: July 6, 2004

  
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Laura A. Coruzzi 30,742  
JONES DAY (Reg. No.)  
222 East 41<sup>st</sup> Street  
New York, New York 10017  
(212) 326-3939